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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/202,244	02/19/99	BREUNIG	S 022701-803

021839 IM22/0915  
BURNS DOANE SWECKER & MATHIS L L P  
POST OFFICE BOX 1404  
ALEXANDRIA VA 22313-1404

EXAMINER

MOORE, M

ART UNIT PAPER NUMBER

1712

DATE MAILED: 09/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.  
**09/202,244**

Applicant(s)  
**Breunig et al.**

Examiner  
**Margaret Glass Moore**

Group Art Unit  
**1712**



☒ Responsive to communication(s) filed on Jul 21, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1 to 21 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 to 21 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20:

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. The omitted steps are: the steps of actually producing the silicone oil. Note that the claimed process only includes one step: the step of providing a catalytic composition. This step on its own does not form a silicone oil.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3 to 9, 11 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jachmann et al.

5. Claims 2, 9, 10, 12, 18, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jachmann et al.

6. Claims 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Jachmann et al.

7. Each of these rejections is based on the reasons of record, as noted in the previous office action. The Examiner notes that applicants do not provide separate traversals for rejections under

35 U.S.C. 102, 35 U.S.C. 102/103 and 35 U.S.C. 103, or even separate traversals for process and product claims. As such, the Examiner will address applicants' traversal as it applies.

Applicants argue that Jachmann et al. fail to disclose or suggest each feature of the claimed invention. Specifically they state that "Jachmann et al. does not disclose hydrosilylating the synthons with the organohydrosiloxane containing only SiH groups, as in the present invention". This statement is not understood in that it is not consistent with the claims. The structures (XVI) and (XVII) do not contain only SiH groups. Note that "a" and "c" are both greater than 0. Note too that the SiH containing reactant in Example 1 meets the claimed formula (XVI).

Applicants next state that "the polyorganohydrosiloxane synthesized by Jachmann et al. contains both SiH and epoxy groups, while the present invention contains only SiH groups". This also is not understood. First, the final product in Jachmann et al. does not have SiH and epoxy groups. It is not even clear how applicants come about this interpretation. Next, as noted supra, the polyorganohydrosiloxane does not include only SiH groups.

In reference to Example 1, applicants note that the product of Jachmann et al. has  $R_3OH$  groups. From this they conclude that the polyorganohydrosiloxane utilized in the hydrosilylation of Jachmann et al. is different from the one of the present invention. However, Example 1 shows a process in which a compound corresponding to the claimed synthon is reacted with a siloxane corresponding to the claimed (XVI). These reactants are the same. Nothing in applicants' claims excludes the hydrosilylation of an allyl alcohol at the same time the synthon undergoes hydrosilylation and nothing excludes such a group from being in the final product claims.

Jachmann et al. prepare siloxanes having  $R_3OH$  groups, but they do not hydrosilylate the epoxy monomer with an SiH containing reactant having these groups. Rather, as can be seen in Example 1, an epoxy synthon undergoes a hydrosilylation reaction with a siloxane having the formula (XVI). The claims do not exclude the addition of any other reactant, such as allyl alcohol in Example 1.

Regarding the statement that Jachmann et al. does not exhibit the non-turbidity and stable viscosity of the silicone oil of the presently claimed invention, the Examiner notes that applicants provide nothing to support this statement. In fact, the siloxanes in Jachmann et al. are preferably used solvent free. If they did not have a stable viscosity, they would be inoperable. In addition, the siloxanes shown are fully reacted, providing no residual reactive sites which would affect the


viscosity. From this it is readily apparent that the siloxanes in Jachmann et al. are viscosity stable. In addition, the Examiner notes that the siloxanes are prepared by the same process and have the same formula as that claimed, thus they would be expected to inherently have the same properties with regards to turbidity and viscosity.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication should be directed to Margaret G. Moore at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) **872-9310**. All other **official** faxes should be sent to (703) **872-9311**. Please do not send any informal communication or proposed amendments to this number.

  
Margaret G. Moore  
Primary Examiner  
Art Unit 1712